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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,783	11/13/2001	Juha Rasanen	975.363USW1	4738
32294	7590	01/13/2005	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			TRAN, PHILIP B	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,783	Applicant(s) RASANEN ET AL.	
	Examiner Philip B Tran	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30, 35-42 and 47 is/are rejected.
- 7) ☒ Claim(s) 31-34 and 43-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 25, 36 and 39 are objected to because of the following informalities:

In claim 25, lines 4, 7 and 9, hyphens in front of each limitation should be omitted.

In claim 36, lines 5, 7 and 9, hyphens in front of each limitation should be omitted.

In claim 39, line 3, item reference number in the parenthesis should be omitted.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 25-28, 30, 36-42 and 47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Itoh et al (Hereafter, Itoh), U.S. Pat. No. 6,421,346.

Regarding claim 25, Itoh teaches an interworking method for a data connection between a first network element terminal (= terminal (A)) supporting a first processing

scheme and a second terminal (= terminal (B)) supporting a second processing scheme, comprising the steps of:

monitoring by an interim network element locating between the first (= terminal (A)) and the second terminals element terminal (= terminal (A)) supporting a first processing scheme and a second terminal (= terminal (B)) the negotiation on a processing scheme between the first and the second terminals, detecting that the second terminal does not support a first processing scheme proposed by the first terminal, and providing by the interim network element an interworking function (= call processing function with interworking controller) for adapting the first processing scheme to a second processing scheme supported by the second terminal [see Fig. 1 and Abstract and Col. 2, Line 30 to Col. 3, Line 4].

Regarding claim 26, Itoh further teaches a method according to claim 25, wherein said monitoring step comprises extracting negotiation symbols indicating said first or second processing schemes during a negotiation processing between said first and second terminals, and comparing said extracted negotiation symbols [see Figs. 1-2 and Col. 9, Lines 39-60].

Regarding claim 27, Itoh further teaches a method according to claim 25, further comprising the step of passing a bit stream via said data connection without adaptation, when said detecting step indicates that said first and second processing schemes are the same schemes [see Figs. 1-2].

Regarding claim 28, Itoh further teaches a method according claim 25, wherein the first and second processing schemes correspond to first and second call setup negotiations [see Abstract].

Regarding claim 30, Itoh further teaches a method according to claim 25, wherein said first and second processing schemes correspond to first and second error correction schemes [see Col. 5, Lines 15-63].

Claims 36-37 are rejected under the same rationale set forth above to claims 25-26, respectively.

Regarding claim 38, Itoh further teaches an apparatus according to claim 37, further comprising a buffer means for storing said information indicating said first and second processing schemes, wherein said comparing means is arranged to read said information indicating said first and second processing schemes from said buffer means [see Fig. 1].

Regarding claim 39, Itoh further teaches an apparatus according to claim 36, further comprising switching means for by-passing said providing means, when said detecting means determines that the first processing scheme is supported by the second terminal [see Figs. 1-2].

Claims 40-42 are rejected under the same rationale set forth above to claims 28-30, respectively.

Regarding claim 47, Itoh further teaches an apparatus according to claim 36, wherein said interworking apparatus is a network element having an interworking function [see Fig. 1].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al (Hereafter, Itoh), U.S. Pat. No. 6,421,346 in view of Toga et al (hereafter, Toga), "ITU-T Standardization Activities for Interactive Multimedia Communications on Packet-based Networks : H.323 and Related Recommendations", Computer Networks and ISDN Systems, Vol. 31, No. 3, Pages 205-223, 2/11/1999.

Regarding claim 29, Itoh further teaches call setup negotiation is digital setup negotiation (= ISDN) [see Col. 1, Lines 15-25]. Itoh does not explicitly teach call setup negotiation is an analog setup negotiation. However, Toga, in the same field of interworking function (= gateway) communication network endeavor, discloses call setup negotiation is an analog setup negotiation through a modem [see Fig. 1]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Toga into the system of Itoh in order to efficiently enable data transmissions between terminals using different data protocols.

Regarding claim 35, Itoh does not explicitly teach data connection is a multimedia connection. Toga, in the same field of interworking function (= gateway) communication network endeavor, discloses audiovisual and multimedia service connection [see Abstract and Fig. 1]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Toga into the system of Itoh in order to efficiently enable data transmissions between terminals using different data protocols for sharing a rich mixture of audio, video and data across all forms of packet-based networks such as intranet and internet via gateway.

Allowable Subject Matter

6. Claims 31-34 and 43-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other References Cited

7. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

- A) Jacobsohn, U.S. Pat. No. 5,917,816.
- B) Boudreaux et al, U.S. Pat. No. 5,909,648.
- C) Sallberg, U.S. Pat. No. 6,073,018.
- D) Howell et al, U.S. Pat. No. 6,483,837.
- E) Cunningham et al, U.S. Pat. No. 6,453,174.

8. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS, OR THIRTY DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991.

The Group fax phone number is (703) 746-7239.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam, can be reached on (571)-272-3978.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Philip Tran
Philip B. Tran
Art Unit 2155
Jan 05, 2005